

**REMARKS/ARGUMENTS**

Claims 1-7 and 9-20 are currently pending in the present application. Claims has been amended. Claim 8 was previously cancelled. Claim 1 has been amended recite that the compound of component iii "comprises two or more epoxy groups in the molecule." Support for the amendment can be found in the specification at page 13, lines 17-18, as originally filed. No new matter has been added.

Applicants thank the Examiner for withdrawing the rejections under 35 U.S.C. §§ 101 and 112.

Reconsideration of the application is respectfully requested in view of the following remarks.

**Rejection Under 35 U.S.C. § 103**

The rejection of claims 1-20 under 35 U.S.C. 103(a) as obvious over Warzelhan et al. (US Patent No. 6,018,004) in view of Hager et al. (US Patent No. 5,373,058) is respectfully traversed for reasons of record and the additional reasons below.

As the Board of Patent Appeal and Interferences has recently confirmed, a proper obviousness determination requires that the Office make "a searching comparison of the claimed invention - *including all its limitations* - with the teaching of the prior art." *See In re Ward and Murphy*, Appeal 2007-3733, citing *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis in original); *see also Ex parte Martin Haubner and Rolf Pinkos*, Appeal No. 2009-0449 (explaining that "in rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a case of prima facie obviousness"). Moreover, as the Supreme Court stated, "*there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.*" *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (emphasis added)).

In present case, Applicants point out that the Office has not shown, other than improper hindsight of the present specification, that the cited references of record describe *all* of the limitations of the claimed biodegradable polyester mixture process, e.g., components i and ii. In particular, the Office uses Hager et al. to overcome the apparent deficiencies of Warzelhan et al.

However, there is no showing or reference in Hager et al. to biodegradable polymers, i.e., components i and ii are missing. The reference only indicates a copolyester built via polymerization of glycidyl acrylate monomers, on the one hand, and glycol and diacid (polyester) monomers, on the other side. As such, the reference does not cure the deficiencies of Warzelhan et al.

Furthermore, there is no indication, as previously argued that Warzelhan et al. nor any of the other recited reference describes the benefits achieved with the claimed biodegradable polymer mixtures. In particular, as described in the present specification, provides mixtures which contain a high fraction of inexpensive and ecologically sound renewables and which have improved degradation rates as well as good processing and mechanical properties. Present specification at page 2, lines 17-20; *see also* the Examples at pages 15-19 and Tables 1-3.

Therefore, the claimed process is novel and non-obvious. Accordingly, withdrawal of the rejections is requested.

In view of the foregoing, consideration and allowance are respectfully solicited.

In the event the Examiner believes an interview might serve in any way to advance the prosecution of this application, the undersigned is available at the telephone number noted below.

The Office is authorized to charge any necessary fees to Deposit Account No. 03-2775.

Applicants believe no fee, other than the RCE fee, is due with this response. However, if an additional fee is due, please charge our Deposit Account No. 03-2775, under Order No. 12810-00192-US1 from which the undersigned is authorized to draw.

Dated: May 4, 2009

Respectfully submitted,

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